

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

118744-193

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on _____

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Typed or printed name _____

Application Number

10/089,252

Filed

March 28, 2002

First Named Inventor

Patrick KLEINER et al.

Art Unit

2614

Examiner

R. S. Al Aubaidi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 43,148

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

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202.955.7007

Telephone number

August 30, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 2 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Patrick KLEINER et al.
Appl. No.: 10/089,252
Conf. No.: 2930
Filed: March 28, 2002
Title: SYSTEM AND METHOD FOR HANDLING AN INCOMING OR OUTGOING
CALL TO OR FROM A SUBSCRIBER TERMINAL OF A SUBSCRIBER
GROUP
Art Unit: 2614
Examiner: R. S. Al Aubaidi
Docket No.: 118744-193

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated June 1, 2007. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

I. THE REJECTION TO CLAIMS 1-8 UNDER 35 USC 103(A) AS UNPATENTABLE OVER DAVIDSON IN VIEW OF FOSTER IS IMPROPER

Claims 1-8 are rejected under 35 USC 103(a) as being unpatentable over Davidson, U.S. Patent No. 4,873,717 in view of Foster, U.S. Patent No. 4,757,526. This rejection is traversed.

A. The Arguments

The Examiner asserts that Davidson teaches the claimed features but does not teach or suggest a Centrex group. The Examiner relies on Foster as teaching this feature and asserts that it would have been obvious to have modified Davidson in view of Foster to provide “and extends [sic] a number of service features to the business group.” On page 6 of the Final Office Action, the Examiner states that “modifying the primary reference Davidson will add more to the system. Obviously adding more features will definitely [sic] enhance the system and expands its flexibility.” (See, Response to Arguments). Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to modify Davidson in view of Foster to create the claimed invention. Moreover, simply modifying a reference to “add more to the system” is not motivation, nor is it an innovation beyond normal skill and common sense.

B. The Davidson Reference Already Provides a Mechanism for Solving the Problem One Way, and One Skilled in the Art Would Not be Motivated to Modify the Reference to Solve the Problem in Another Way

Foster relates to Centrex services provided to subscribers having a main location connected to one local exchange and a remote or satellite location connected to another local exchange (col. 1, lines 11-14). Incoming calls from the outside come in via the main location exchange (col. 1, lines 14-16). Davidson, on the other hand, relates to a call coverage arrangement in which coverage personnel are informed of the switch-hook status of covered terminals by way of a single two-part indicator on the coverage terminal (abstract). Applicants submit that there would have been no reason for one to modify Davidson to provide a Centrex group. Doing so would not add anything to the system disclosed in Davidson. “The totality of

the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness.” MPEP 2145 (citing *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986), 228 USPQ 685; “Known disadvantages in old device which would naturally discourage search for new inventions may be taken into account in determining obviousness.” MPEP 2145 (citing *United States v. Adams*, 383 US 39, 52, 148 USPQ 479, 484 (1966)); “Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *KSR Intern. Co.*, 127 S.Ct. at 1740.

Further, the Examiner has not pointed to any specific evidence of record which supports the stated motivation to combine these references. Merely stating that it would provide and extend a number of services to the business group, and that modifying the primary reference will add more to the system and provide expanded flexibility does not address any of the problems sought to be addressed in Davidson. Davidson does not care about providing services to the business group, Davidson is only concerned with the switch-hook status of covered terminals. Further, Davidson is not concerned with the way in which calls are routed to remote locations (as in Foster), but rather whether it is appropriate to route calls at all, thus the switch-hook status information. The Examiner responds by stating that Davidson deals with “Call Coverage Arrangement” and therefore is not “only concerned with the switch-hook status of covered terminals.” While Davidson indeed deals with a “call coverage arrangement”, the coverage personnel are informed of the switch-hook status of covered terminals in the arrangement. The switch-hook aspect is essential to the invention, and without it does not operate (see, for example, the abstract). Additionally, the specification clearly notes that recognized deficiencies of the prior art include inefficient call handling afforded by call coverage arrangements that fail to inform coverage personnel of the switch-hook status of covered multiple call appearance terminals (see, for example, col. 2, lns. 31-40). Thus, it is clear that Davidson seeks to solve the long recognized deficiency in the prior art of failing to inform

personnel of switch-hook status. Applicants therefore submit that one of ordinary skill in the art would not have been motivated to modify Davidson in view of Foster to create the claimed invention. Applicants request that this rejection be withdrawn.

In light of the above, Applicants respectfully submit that the rejection to claims 1-8 is improper and should be reversed by this Panel. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (118744-193) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

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Dated: August 30, 2007